

REMARKS

Claims 1-26 are pending in the application.

Claims 1-26 have been rejected.

Claims 1, 3, 18, 21 and 23-24 have been amended, as set forth herein.

Claims 25-26 have been canceled, without prejudice.

New Claim 27 has been added.

I. **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-9, 15-17 and 19-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) in view of Dodrill, et al. (US 6,490,564). Claims 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) as applied to Claim 1, and further in view of Luzeski, et al. (US 6,301,245). Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) in view of Dodrill, et al. (US 6,490,564) as applied to Claim 1, and further in view of Boursier et al. (US 5,675,333). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness

is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Independent Claims 1, 23 and 24 (method, computing device and computer readable medium) each recite “a voice message file in a compressed file format” such that the “received voice message comprises a compressed audio portion and an information portion” and the “compressed audio portion is generated by conversion from a first file format to the compressed file format”. See,

Claims 1, 23 and 24, as amended (underline emphasis added). Helfrich does not disclose, teach or suggest such elements/features.

In addition, Boursier does not disclose, teach or suggest such elements/features. Boursier recites a sound recorder that receives audio (speech or sound) in analog format, and converts the analog audio into digital samples) using a analog-to-digital (A/D) converter (having a fixed sampling rate). The digital samples are compressed either at a first compression rate (e.g. 8 kbits/second) or a second compression rate (e.g. 5 kbits/second) which yields a compressed signal. Col. 2, line 53 to Col. 3, line 40. In distinct contrast, Applicant's claimed invention receives a voice message file in a compressed file format, wherein the voice message file includes a compressed audio portion and an information portion, and the compressed audio portion was generated by conversion from a first file format to the compressed file format. Boursier does not disclose, suggest or teach receiving a voice message file, or a voice message file including a compressed audio portion and an information portion. Moreover, Boursier does not appear to relate to or address any conversion from a first file format to a compressed file format.

With respect to independent Claims 25 and 26, these claims have been canceled without prejudice.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1- 26.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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